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TO:	FROM:
Examiner Azizul Choudhury	Brett A. Carlson (Reg. No. 39,928)
COMPANY:	DATE:
USPTO	NOVEMBER 16, 2006
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	ATTN: Brett Carlson
RE:	REFERENCE NUMBER:
Appeal Brief	09/606,786
NOTES/COMMENTS:	

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/606,786	RECEIVED CENTRAL FAX CENTER NOV 16 2006
	Filing Date	06/28/2000	
	First Named Inventor	Murphy	
	Art Unit	2145	
	Examiner Name	Chandhury	
	Attorney Docket Number	34918.0100/BAC	
Total Number of Pages in This Submission	13		

ENCLOSURES (Check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Ingrassia Fisher & Lorenz PC		
Signature			
Printed name	Brett A. Carlson		
Date	November 16, 2006	Reg. No.	39,928

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Typed or printed name	Brett A. Carlson	Date	11/16/2006


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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Murphy et al. Group Art Unit: 2145
Serial No.: 09/606,786 Examiner: Choudhury, Azizul Q.
Filed: June 28, 2000 Confirmation No.: 6327
For: *METHOD AND APPARATUS FOR MAINTAINING A COMPUTER SYSTEM*
Attorney Docket No.: WNF/B. Carlson

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on <u>11/16/2006</u>	Signature: <u></u> Brett A. Carlson

APPEAL BRIEF SUBMITTED UNDER 37 C.F.R. 41.37

MAILSTOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Commissioner:

The Examiner has repeatedly refused to allow our patent application, stating that our invention is anticipated by art that clearly fails to meet each and every limitation of our claims. With all due respect to the Examiner, the cited art falls far short of disclosing at least several aspects of our claimed inventions. We appealed the Examiner's final decision to the Board of Patent Appeals and Interferences to resolve a single factual question:

Does the Chang Reference cited in the Office Actions disclose each and every one of the limitations found in our claim 1?

As evidenced by the size of the file wrapper in this matter and the length of time that this Application has remained pending, we have attempted to resolve this question with the Examiner on several occasions, and we remain firmly resolved that the Chang reference continually cited by the Examiner falls well short of disclosing each and every element of our claimed inventions.

Each of the items required by 37 C.F.R. § 41.31 are set forth below:

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1. Real Party in Interest

The real party in interest for this invention is WNF Consulting Inc., an Arizona corporation.

2. Related Appeals and Interferences

There are no related Appeals or Interferences.

3. Status of Claims

Claims 1, 3-25, 42-90, 93-101, 105, and 107-116 are pending in the present Application, with claims 1, 42, 90, 105, 111 and 116 being independent claims. Claims 2, 26-41, 91-92, 102-104 and 106 were cancelled in Applicant's prior Responses, and are no longer pending.

Although we believe each of the claims to be patentable for their own reasons, this Appeal relates only to claim 1. Because the same reference is cited against all of the claims, however, the issues raised with regard to claim 1 are relevant to the patentability of the remaining claims.

4. Status of Amendments

No amendments were filed subsequent to the Final Office Action.

5. Summary of the Claimed Subject Matter

As stated in our informal request for review, our inventions generally relate to various systems and techniques for remotely maintaining a number of personal computers interconnected by a network. Broadly speaking, a server computer system provides an "attribute determination" program to each client computer being maintained to determine the particular attributes (e.g. computer brand, model, operating system, hardware capabilities, etc.) of that client computer. The attribute determination program reports these attributes back to the server, which then selects one of a set of management instructions based upon the particular attributes of the client computer and provides these instructions to the client computer for subsequent execution. Each of these steps is performed without booting the local operating system on the client computer, thereby allowing the server to provide powerful diagnostic and repair features. Notably, this system is capable of determining attributes of a previously-unknown computer client and of

selecting management instructions based upon those particular attributes. This functionality is highly useful and powerful, yet not even remotely suggested in the prior art.

With particular reference to independent claim 1 (and with reference to the originally-filed application, including reference numerals), one exemplary method of remotely maintaining a client computer [202] from a server computer [206] is described. The client computer [e.g. p. 1, line 18 through p. 2, line 5] comprises a plurality of attributes [e.g. p. 34, lines 17-24], a network interface card (NIC) [e.g. 102] and a local operating system [106]. The method comprises the step of providing a preboot attribute determination application [e.g. boot image 500] from the server computer to the client computer via the network interface card prior to said client computer loading said local operating system [FIG. 4B, step 334]. Said plurality of attributes of said client computer are determined [FIG. 4B, step 330; see also p. 7, lines 10-15] with the preboot attribute determination application executing on said client computer prior to said client computer loading said local operating system. Said plurality of attributes from said client computer are then received at the server computer [FIG. 4B, step 318], which then automatically selects [FIG. 4B, step 324] one of a plurality of management instruction sets [e.g. scripts 302 in FIG. 3] stored on said server computer for said client computer. Said one of said plurality of management instruction sets is selected by said server computer based upon said plurality of attributes of said client computer determined by said preboot attribute determination program [see, e.g., p. 7, lines 14-16]. Said one of said plurality of management instructions is provided from said server computer to said client computer [FIG. 4B, step 326] to thereby allow said client computer to execute said one of said plurality of management instruction sets at said client computer prior to loading said local operating system [FIG. 4B, step 322; see also p. 24, line 15-p. 25, line 7]. Additional information about this exemplary process can be found in the original specification at, for example, p. 19, line 12 through p. 26, line 10.

We strongly believe that at least the “determining” and “automatically selecting” steps are not disclosed in the prior art of record. Again, although our application contains numerous claims that are each patentable for their own reasons, for purposes of this Appeal we will focus primarily on the particular language of claim 1.

6. Grounds of Rejection to be Reviewed on Appeal

We request review of a single point relating to the Section 102(b) rejection of claim 1 contained in the Final Office Action dated July 5, 2005:

Does the Chang Reference disclose our claimed limitations of (1) determining the attributes of a client computer with an application provided by a server computer...; and (2) automatically selecting one of a plurality of instruction sets stored on the server computer for said client computer based upon the determined attributes of the client computer?

Upon review of the file wrapper and evidence presented, we believe that the Board will answer this question in the negative. Simply stated, the "attribute determining" and "automatic selection" features of our claim are simply not found within the metes and bounds of the Chang reference. As a result, the Section 102 rejection of the claim cannot be maintained.

7. Argument

The single issue presented to the board is relatively simple and straightforward: does the reference cited by the Examiner disclose each and every element of our claim 1, as required to support a rejection under 35 U.S.C. § 102(b)? It is our strong contention that does not.

As we have noted above, our invention in claim 1 relates to a method of remotely maintaining a client computer system from a server computer. The server provides an attribute determination program that determines certain characteristics of the client, the program reports these characteristics back to the server, and then the server selects an appropriate administration script for the client based upon the determined characteristics of that computer. In particular, there are at least two elements of claim 1 that are clearly not found within the scope of the cited reference. Claim 1 is reproduced below for convenience:

1. A method of remotely maintaining a client computer from a server computer, wherein the client computer comprises a plurality of attributes, a network interface card (NIC) and a local operating system, the method comprising the steps of:

providing a preboot attribute determination application from the server computer to the client computer via the network interface card prior to said client computer loading said local operating system;

determining said plurality of attributes of said client computer with the preboot attribute determination application executing on said client computer prior to said client computer loading said local operating system;

receiving said plurality of attributes from said client computer at the server computer;

automatically selecting one of a plurality of management instruction sets stored on said server computer for said client computer, wherein said one of said plurality of management instruction sets is selected by said server computer based upon said plurality of attributes of said client computer determined by said preboot attribute determination program; and

providing said one of said plurality of management instructions from said server computer to said client computer to thereby allow said client computer to execute said one of said plurality of management instruction sets at said client computer prior to loading said local operating system.

We strongly believe that at least the highlighted “determining” and “automatically selecting” steps of claim 1 (as well as various other claims) are not disclosed in the prior art of record. Although we have explained our views on several opportunities (e.g. in the Response to Office Action dated April 7, 2005), the Office continues to reject our claim under 35 U.S.C. § 102(b), citing US Patent No. 5,680,547 (“Chang”). While we acknowledge that the Chang reference does describe a pre-boot file transfer environment (such as the PXE specification that is described at length in our specification¹), Chang’s disclosure is limited to a system for transferring files. It is not intended as a complete administration system, nor is such functionality disclosed within the bounds of the reference. At the very least, the Chang reference does not disclose our claimed details of determining the attributes of the client computer and automatically selecting a set of instructions based upon the determined attributes. To the contrary, Chang is silent as to these features, and therefore falls short of providing the disclosure required to support the Section 102(b) rejection set forth in the Final Office Action.

As we have noted in the record,² the Chang reference cited against Applicant’s claims describes a basic implementation of the pre-boot execution environment (PXE) that was originally developed to allow network interface cards (NICs) to obtain a boot program for a computer over a network. In contrast to the presently-claimed invention, however, Chang only contemplates administration of “predetermined” computer resources that have been previously

¹ See, for example, page 8, line 24 through page 9, line 3 of our Specification.

² Please see our Remarks at page 15-16 of the Response filed April 7, 2005 for a detailed description of the Chang reference and various differences between that reference and the present claims.

known to the server.³ In the Chang system, an administrator manually enters each client computer into an "access control list database" (ACL-DB, shown as element 11a in Chang's FIG. 1), and all access to server resources is contingent upon the server authenticating the client computer with the ACL-DB.⁴ When the computer is later powered up, the computer transmits its NIC address to the server for verification.⁵ Chang's FIG. 3B, for example, expressly shows that the network connection between the client and server is "cut" if the client's NIC address is not recognized in an access control list database.⁶ Chang also expressly states that its preboot process is "controlled by a system administrator,"⁷ further emphasizing that only computer systems that are known to a human operator are considered by the Chang system. Stated another way, Chang simply provides a static set of instructions to a client computer based upon the NIC address entered in the server database; the reference contains no mention whatsoever of automatically selecting instructions based upon the particular attributes of the client machine, nor does it provide a mechanism for determining the attributes of the client machine.

Turning now to the detailed rejection of our claim 1 found in the Final Office Action, the Examiner initially cites col. 2, lines 44-54 of Chang⁸ as disclosing our "attribute determination program" limitation, claiming that "the claimed application must be present since a check is done of the client to determine if it is booted or not". This statement fails to take into account that our claim recites that the application is *provided by the server to the client*. That is, even if Chang does determine whether the client is booted or not, this simple check does not anticipate "*determining the attributes of the client with a client attribute determination application provided from the server to the client*", as recited in our claim 1 and elsewhere.

The Office Action makes numerous claims that our limitations are "inherent" in the Chang reference, without providing any adequate basis for such statements. As an example, the Final Office Action⁹ asserts that "it is inherent that the application contains the claimed management instructions, as well as selects the appropriate management instructions for each client machine", ignoring our express recitation that the instructions are selected based upon the determined attributes of the client computer, a feature clearly not present in the Chang reference.

³ See, e.g., Chang at col. 5, lines 30-32, and the preambles of each independent claim.

⁴ See, e.g., Chang at col. 4, lines 52-60.

⁵ Chang at col. 6, lines 56-58.

⁶ See also Chang at col. 6, lines 56-63.

⁷ See, e.g., Chang at Abstract, last sentence and col. 2, lines 50-52.

⁸ The only portions of Chang cited in the entire rejection of claim 1 are col. 2 lines 7-19 and 44-54.

Indeed, the Final Office Action is entirely silent as to this feature of our claims. As a result, the actual rejection contained within the Final Office Action simply makes broad reference to column 2, lines 44-54 of the Chang reference, claiming that our claim elements "are inherent" or "must be present" from this disclosure, without providing specific citation to the actual features of the reference that disclose each and every limitation of our claims. In fact, Chang does not disclose the various features of our claimed inventions, as described above.

The Final Office Action further summarizes the rejections at pages 67-68, stating that Chang's column 2 discloses the various features found within our 100+ claims. In this section, the Examiner states that Chang discloses pre-boot file transfer, which is asserted to be "equivalent" to our "claimed traits of receiving attributes, selecting management instruction sets and providing management instruction sets". Once again, however, this statement does not include the full breadth of our claim language. Even to the extent that Chang is able to disclose pre-boot file transfer between a client computer and a server computer, the reference in no way discloses determining client computer attributes with an application provided by the server, nor does the reference disclose automatically selecting a list of instructions based upon the determined attributes. Because the reference does not disclose the actual limitations recited in our claim, the rejection under Section 102(b) cannot be maintained.

We therefore request that the Board review the Final Office Action and determine whether US Patent No. 5,680,547 discloses our claimed limitations of (1) *determining the attributes of a client computer with an application provided by a server computer before the client computer has booted its local operating system*; and (2) *automatically selecting one of a plurality of instruction sets stored on the server computer for said client computer based upon the attributes of said client computer determined by said preboot application provided by the server*. For the reasons set forth above, we are confident that neither of these elements are disclosed by the Chang reference in any manner whatsoever.

This Brief is believed to be filed in a timely manner without any need for extensions of time other than those addressed elsewhere in this submission. If for some reason this is not the case, however, Applicant hereby petitions for any extension of time (e.g. any extension from the date that the Notice of Appeal and/or the Final Office Action were mailed)


⁹ At page 4, line 7.

and grants the Commissioner authorization to debit Deposit Account No. 50-2091 for any fees as may be required to consider this Brief and/or to prevent abandonment of this application.

Dated.

11/16/2006

Respectfully submitted,



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8. Claims Appendix

1. A method of remotely maintaining a client computer from a server computer, wherein the client computer comprises a plurality of attributes, a network interface card (NIC) and a local operating system, the method comprising the steps of:
 - providing a preboot attribute determination application from the server computer to the client computer via the network interface card prior to said client computer loading said local operating system;
 - determining said plurality of attributes of said client computer with the preboot attribute determination application executing on said client computer prior to said client computer loading said local operating system;
 - receiving said plurality of attributes from said client computer at the server computer;
 - automatically selecting one of a plurality of management instruction sets stored on said server computer for said client computer, wherein said one of said plurality of management instruction sets is selected by said server computer based upon said plurality of attributes of said client computer determined by said preboot attribute determination program; and
 - providing said one of said plurality of management instructions from said server computer to said client computer to thereby allow said client computer to execute said one of said plurality of management instruction sets at said client computer prior to loading said local operating system.

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9. EVIDENCE APPENDIX

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 has been entered by the Examiner or relied upon by Appellant in the instant appeal beyond that which is already contained in the as-filed application, as delineated in the Arguments section of this Brief.

10. RELATED PROCEEDINGS APPENDIX

As there are no related appeals and interferences set forth in Section 2 above, there are also no decisions rendered by a court or the Board of Patent Appeals and Interferences that are related to the instant appeal.